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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,037	07/29/2003	Richard Henry Parker	5601	9275

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/631,037	Applicant(s) PARKER, RICHARD HENRY	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18, 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments filed 10/20/05, with respect to the scope of enablement rejection made under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. There seems to now be sufficient evidence on the record that determining what polymers (ii) may be combined with the silicone polymer to provide the claimed IPN would not represent an undue burden on one having ordinary skill in the art. Accordingly, this rejection is hereby withdrawn.

Still, the Examiner now has concerns regarding the intended meaning of a sentence provided in paragraph 11 of the Specification. In particular, Applicant states:

Whereas previous attempts—as are described in US Patents 6,348,543; 6,468,929; and 6,545,092—were successful in forming silicone blends to improve the properties of silicone, such as resistance to seam combing in airbags, these attempts did not address the thermodynamic properties of the silicone polymers compared to those polymers that are blended with silicone to form an IPN.

The Examiner had originally believed that this statement was intended to explicitly acknowledge that the systems taught by this reference were not, in fact, in compliance with the cohesion parameter relationship mandated of the silicone and a second polymer. However, after further deliberation, the Examiner concluded that Applicant might possibly have been implying only that the meaningfulness of similar cohesion parameters *had not yet been recognized*. If this is true, than it very well may be the case that that the semi-IPNs taught by the prior art do inherently satisfy the difference in cohesion parameter criterion. Given that the second polymers of the prior art are, like the preferred second polymer of the instant invention, ethylene-methyl acrylate copolymers, it is certainly reasonable to assert that IPNs derived from the second

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polymers of the prior art would inherently possess the required difference in cohesion parameters.

The Examiner sincerely regrets any inconvenience this may have caused Applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-12, 15-18, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker, U.S. patent # 6,348,543. Parker discloses the manufacture of coated woven (column 3, lines 22-23) airbags wherein the coating composition comprises in a preferred embodiment a vinyl-functional polysiloxane, ethylene-methyl acrylate copolymer, peroxide curing catalyst, and 3-methacryloxypropyltrimethoxysilane. Of course, upon curing the vinyl-functional silicone polymer in the presence of the vinyl copolymer, a semi-IPN is formed. The polysiloxane and ethylene-methyl acrylate copolymer taught by *Parker* will inherently satisfy Applicant's limitation directed to the difference in their cohesion parameter given that these same types of polymer are employed in the present invention.

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Section 2112.01 of the MPEP emphasizes that, "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). "Whether the rejection is based on inherency under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). However, "A prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product." *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

Suitable substrates include any of woven, non-woven, and knitted fabrics according to column 3, lines 13-16.

Claims 10-12, 15-18, 20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker, U.S. patent # 6,545,092, and Parker, U.S. Patent # 6,468,929.

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

All citations of column and line location are the same as those for '543. The '092 and '929 disclosures are based on continuation applications of the application from which '543 evolved and, therefore, will have an identical disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parker, U.S. Patent # 6,348,543.

The phrase “Jacquard woven cushion” connotes a product-by-process as in a “cushion woven using a Jacquard fluid jet loom”.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Parker says that the

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fabric substrates of their invention are preferably woven using a fluid jet weaving machine, of which a Jacquard machine is one type. Although it is appreciated that other types of fluid jet looms exist, such as a dobby loom, it is the position of the Examiner that the woven products are essentially the same. In any case, the utilization of a Jacquard loom and, thus, the manufacture of a Jacquard woven article, is at least obvious in view of the limited number of known fluid jet weaving devices.

Claims 13 and 14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parker, U.S. patent # 6,545,092, and Parker, U.S. Patent # 6,468,929.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-13, 17-18, and 22 are rejected on the ground of nonstatutory double patenting over claims 3 and 6 of U. S. Patent No. 6,846,004 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. The claims of the instant application and those of the patent differ primarily in two ways (i) the identity of the polar monomer is not specified and, thus, it is not immediately clear that the copolymer of the patent claim has a cohesion parameter within 3 units of the silicone, and (ii) the coating is described as a "blend" in the patent claim as opposed to as a semi IPN.

The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first, "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined."

Clearly, a preferred Example meets the measure of that portion of a Specification that supports the claims, and therefore, may be considered in interpreting the claims.

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The patent claims state that the second polymer is a copolymer of ethylene and a polar monomer. In every example, the copolymer is VAMAC 2036-1 which, incidentally, is *precisely the same* copolymer as is used by the instant invention. Accordingly, it may be fairly asserted that by, "copolymer of ethylene and a polar monomer", Parker had intended VAMAC 2036-1. In that instance, the cohesion parameter limitation is unmistakably satisfied. As for the notion that the patent teaches a blend instead of a semi-IPN, it is noted that to the blend is added a catalyst which, of course, promotes the reaction of the vinyl groups bonded to the silicone in which case a semi-IPN would be realized.

Allowable Subject Matter

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There is no clear impetus for replacing the methacryl-functionalized silane contemplated by the reference with one containing an isocyanato group.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 21, 2005

Marc Zimmer
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AU 1712